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| 10/772,014  | 02/04/2004  | Karl Manser          | M0215.0001/P001     | 4081             |
| 32173 7590 09/04/2008<br>DICKSTEIN SHAPIRO LLP<br>1177 AVENUE OF THE AMERICAS (6TH AVENUE)<br>NEW YORK, NY 10036-2714 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| CROW, STEPHEN R   |             |                      |                     |                  |
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/772,014  
Filing Date: February 04, 2004  
Appellant(s): MANSER, KARL

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Richard LaCava  
For Appellant

**EXAMINER'S ANSWER**

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This is in response to the appeal brief filed May 27, 2008 appealing from the Office action mailed September 26, 2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(8) Evidence Relied Upon**

|           |               |         |
|-----------|---------------|---------|
| 4,925,183 | KIM           | 5-1990  |
| 5,066,000 | DOLAN         | 11-1991 |
| 6,210,349 | NARUSE ET AL  | 4-2001  |
| 6,029,962 | SHORTEN ET AL | 2-2000  |

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9,10,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view of Dolan and Naruse et al.

Kim discloses a treadmill belt 250 having a plurality of projections.

Dolan teaches the general concept of a plurality of walking surfaces which have different textures and densities and which can be used individually or in a serial path.

Naruse et al teaches the exchanging of a stimulating member 5 for a different one to obtain different stimuli or replacement. See column 2 lines 7-11.

The examiner contends that, in view of the Naruse et al kit teaching and the Dolan teaching of differently textured walking surfaces, it would have been obvious to one

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skilled in the exercise art to provide a second or plurality of belts having different characteristics, such as different heights, for providing a change in difficulty or experience while on the treadmill.

3. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view of Dolan and Naruse et al, as applied to claim 9 above, and further in view of Shorten et al.

Shorten et al states in paragraph 41: The indentations and inserts can be adapted to make one part of the shock absorbing structure stiffer in compression than the other part. There are a number of different ways to provide this difference in compression. A smaller hemisphere radius may be used for the indentations on one part of the structure. Inserts made of a material with a higher modulus of elasticity may be used in the indentations on one part of the structure. Alternatively, inserts with greater wall thickness may be used for the indentations on one part of the structure.

Given this teaching, it would have been obvious to one skilled in the art to modify the Kim treadmill belts by utilizing a different modulus of elasticity for producing a different effect during locomotion on the treadmill belts.

#### **(10) Response to Argument**

With respect to Appellant's arguments in Grouping VII A, on pages 5-6 of the brief:

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

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are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It is unnecessary that Kim disclose multiple belts having different surfaces, under a 103 obviousness analysis.

The examiner has relied upon Dolan as teaching a concept, and not a literal and exact substitution of the Dolan structure into the Kim device. As stated above, the examiner stated: “Dolan teaches the general concept of a plurality of walking surfaces which have different textures and densities and which can be used individually or in a serial path”. This general teaching suggests the desirability of plural textured surfaces for translation thereon. The Dolan teaching would suggest to one skilled in the exercise art the use of plural textured surfaces on user exercise surfaces, such as the Kim textured treadmill surface.

Naruse et al, as stated supra, “teaches the exchanging of a stimulating member 5 for a different one to obtain different stimuli or replacement” (of the member). See column 2 lines 7-11. Hence, Naruse et al would suggest to one skilled in the related arts the desirability of substituting a different textured surface to obtain different stimuli. For this reason, Naruse et al would suggest the use of a second, differently textured surface for use in the Kim exercise device. This would have been simply accomplished by providing a second belt having a different textured surface, and would be obvious in view of the collective teachings of Dolan and Naruse et al.

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With respect to Appellant's arguments in Grouping VII B, on page 7 of the brief:

The limitation “at least two separate belts” has been met by Kim in view of Dolan and Naruse et al, *supra*.

The limitations “dimensioned for direct foot contact” and “to impart proprioceptive demands on the foot, ankle and lower leg” are inherently met when a person walks on the Kim treadmill belt during mounting of the bicycle.

With respect to the claim interpretation, the claims are basically directed towards subcombination elements (belts) which are not used together. The claims are not even a kit in the manufacturing sense wherein the parts are interrelated. Therefore, there is no structural cooperation between the claimed belts.

Conventionally, “kits” are an assembly of elements which are usable together. The examiner acknowledges that group or “kit” of interrelated parts is a proper 35 U.S.C. 101 “manufacture,” and is not excluded from patent protection.

However, the claim does not positively recite structural relationships of the two belts. Although the preamble refers to the structure as a “kit”, the elements are recited without present cooperation. The language implies a futuristic use.

Accordingly, the claiming of separately usable belts is not afforded patentable weight.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

sc/Steve R Crow/

Primary Examiner, Art Unit 3764

Conferees:

/LoAn H. Thanh/